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IBM CORPORATION, INTELLECTUAL PROPERTY LAW
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JANVIER, JEAN D

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN PETER KEPROS, MICHAEL ROBERT LENZ,
and RICK WILLIAM STUART

Appeal 2007-2545
Application 09/835,731
Technology Center 3600

Decided: April 30, 2008

Before JENNIFER D. BAHR, LINDA E. HORNER, and DAVID B.
WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §§ 6(b) and 134(a) from the final rejection of claims 1, 4-21, 24, and 27-44.

Representative claim 1 reads as follows:

1. A method for processing electronic rebates utilizing a rebate server computer system, the method comprising:

linking a purchase identifier to a purchase of a product, wherein the linking comprises:

receiving, by the rebate server computer system via a network, a request for the purchase identifier from a store computer system connected to the network;

generating, by the rebate server computer system, the purchase identifier for the purchase of the product: and

transmitting, by the rebate server computer system via the network, the purchase identifier to the store computer system;

receiving information, via the network, entered by a user of a user computer system to complete a rebate claim for the purchased product;

verifying the received information to determine whether the received information includes a match to the purchase identifier previously generated by the rebate server computer system; and

accepting the rebate claim from the user if the received information is verified as a valid rebate claim.

The references set forth below are relied upon as evidence of obviousness:

Lemon	US 4,674,041	Jun. 16, 1987
Van Dusen	US 6,175,823 B1	Jan. 16, 2001
Quinlan	US 6,748,365 B1	Jun. 8, 2004

Claims 1, 4-9, 11-21, 24, 27-32, and 34-44¹ stand rejected under 35 U.S.C. § 103(a) as unpatentable over Quinlan in view of Van Dusen.

¹ The Examiner's omission of claims 14, 18, and 37 from the statement of the rejection in the Final Rejection and Answer appears to be an inadvertent

Claims 10 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Quinlan and Van Dusen and in further view of Lemon.

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of ordinary skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

error, in light of the Examiner’s discussion of these claims in the rejection (Final Rejection 13; Answer 13).

Rejection of claims 1, 4-9, 11-21, 24, 27-32, and 34-44 under 35 U.S.C. § 103(a) as unpatentable over Quinlan in view of Van Dusen.

Appellants argue all of these claims as a group.² Appellants make three arguments:

1. The Examiner has failed to establish a prima facie case because neither Quinlan nor Van Dusen teaches, shows, or suggests all of the claim limitations of independent claims 1, 16, and 24 and the claims depending therefrom. In particular, Appellants argue that neither reference teaches “transmitting, by the rebate server computer system via the network, the purchase identifier to the store computer system.” (Br. 14-15).
2. Van Dusen is non-analogous art because Van Dusen teaches a method for processing gift certificates, not processing electronic rebates, and is not reasonably pertinent to the problems with which the present inventors are concerned, nor would Van Dusen logically commend itself to the attention of one considering the Appellants’ problem (Br. 13).

² Appellants also seem to be arguing claims 10 and 33 as part of the rejection over Quinlan and Van Dusen (Br. 10-13). Although the Examiner stated that the Appellants’ statement of the grounds of rejection to be reviewed on appeal is correct (Answer 2), claims 10 and 33 were, in fact, rejected under 35 U.S.C. § 103(a) as being unpatentable over Quinlan and Van Dusen and in further view of Lemon (Answer 14-16). As discussed more fully below, we find the Appellants arguments to be dispositive of both rejections.

3. One of skill in the art would not be motivated to combine the references, because Van Dusen and Quinlan are directed to such vastly different models and problems (Br. 15).

We agree with Appellants that none of the references teach “transmitting, by the rebate server computer system via the network, the purchase identifier to the store computer system.” Because this argument is dispositive for all appealed claims, we need not reach the Appellants’ remaining arguments.

Quinlan teaches a system and method for processing product marketing rebate claims submitted by a consumer in satisfaction of a rebate offer. To satisfy the rebate offer, the consumer purchases designated products in a qualified transaction recorded by a point-of-sale data processing and storage system that issues a receipt containing a corresponding transaction number (Quinlan, abstract). A designated site of a computer information network is accessible to the consumer for submitting a rebate claim. A rebate claim comprises at least one transaction serial number corresponding to a qualifying transaction and information identifying the consumer. An electronic stored data record that includes the transaction serial number and consumer identifying information is transferred from the point-of-sale system to the designated site. The stored data record is associated with a corresponding purchase data record having an identical transaction serial number, and the stored data record and the corresponding purchase data record associated therewith are then processed to validate the rebate claim. Then, the value of the rebate claim is transferred to the consumer (Quinlan, col. 4, l. 38 – col. 5, l. 3, col. 6, ll. 35-36). Quinlan does not teach “transmitting, by the rebate server computer

system via the network, the purchase identifier to the store computer system.”

Van Dusen teaches an electronic gift certificate system which distributes electronic gift certificates in the form of e-mail documents that include hyperlinks for automating the redemption process. When a gift certificate recipient clicks on such a hyperlink, the recipient’s computer automatically transmits a claim code or other identification information to the merchant’s web site, and the site responds by automatically crediting the recipient’s personal account with the gift certificate amount. When the recipient subsequently makes a purchase from the merchant’s web site, the recipient’s account balance is automatically applied to the purchase price. (Van Dusen, col. 1, ll. 54-67). Van Dusen does not teach “transmitting, by the rebate server computer system via the network, the purchase identifier to the store computer system.”

The Examiner found that, with respect to Quinlan:

It should further be recognized here that the cash value or credit transferred to the retailer's POS system for later upload to the consumer's smart card memory should indeed include at least the transaction code or serial number or purchase identifier related to the previously submitted rebate claim such that all parties involved in the transaction are notified that the transferred credit is associated with a particular transaction identifier and appropriate records are kept (silently requesting or transmitting a transaction serial number or identifier to the store system). See col. 16: 52 to col. 17: 10; col. 18: 30-54; col. 19: 57 to col. 20: 2.

(Answer 9). The Examiner's findings are based on what the disclosed upload "should include," not what it is disclosed to include. The cited passages of Quinlan respectively teach the use of a single fulfillment administrator by a number of unrelated retail chains, transferring the cash value of the rebate to the consumer, and providing the status of rebate processing to the consumer. They do not teach "transmitting, by the rebate server computer system via the network, the purchase identifier to the store computer system." In fact, the Examiner concedes that, with respect to claims 1, 16 and 24,

Quinlan does not expressly disclose generating by a rebate server a purchase identifier in response to a store POS request or remote station, transmitting the purchase identifier to the store POS or remote station and verifying or validating a rebate claim by comparing a submitted purchase identifier to the purchase identifier previously generated by the server.

(Answer 10) (emphasis added).

The Examiner also found that Van Dusen teaches:

transmitting a unique purchase identifier or claim code to a remote computer or user's computer (the store's computer in the claim) during a (purchase) transaction upon receiving a signal from the remote computer used by a buyer to purchase a gift certificate from a web site related to the server (rebate server computer system), wherein the purchase identifier (claim code) is appended to the gift certificate and wherein the claim code or purchase identifier is used during the gift certificate and used during a redemption (a gift certificate claim) by the recipient to verify the authenticity of the gift certificate, thereby

preventing fraudulent activities often associated with the issuance and redemption of coupons, rebates, gift certificates, etc.

(Answer 17). The Examiner appears to be equating transmitting a unique purchase identifier for a gift certificate directly to the recipient with transmitting a unique purchase identifier by the rebate server to the store computer system. The Examiner provides no reason why transmitting a gift certificate meets the claim limitation for transmitting a unique purchase identifier to a store computer. The Examiner thus has failed to make a prima facie case of obviousness. Because each of claims include the limitation “transmitting, by the rebate server computer system via the network, the purchase identifier to the store computer system,” the Appellants have shown the Examiner erred in rejecting 1, 4-9, 11-21, 24, 27-32, and 34-44 under 35 U.S.C. § 103(a) as unpatentable over Quinlan in view of Van Dusen.

Rejection of claims 10 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Quinlan and Van Dusen and in further view of Lemon.

Appellants do not separately address this rejection, but include claims 10 and 33 in their arguments above. However, claims 10 and 33 depend from claims 1 and 24, respectively, and include the limitation “transmitting, by the rebate server computer system via the network, the purchase identifier to the store computer system.” As discussed above, neither Quinlan nor Van Dusen discloses that limitation.

Lemon teaches a controlled coupon advertisement and distribution system which enables the manufacturer to control its liability for coupons and to deter fraudulent redemption (Lemon, col. 1, ll. 55-60). The system enables the manufacturer to limit the number of a particular coupon issued from a terminal as well as the number issued in response to activation by a particular credit card (Lemon, col. 2, ll. 16-19). Lemon does not remedy the deficiencies of Quinlan or Van Dusen. Since the Appellants argue that claims 10 and 33 are patentable (along with the claims in the above rejection) because the Examiner has failed to establish a prima facie case, and Lemon does not remedy the deficiencies in that case, we also reverse the rejection of claims 10 and 33 for failure to establish a prima facie case of obviousness over Quinlan, Van Dusen, and Lemon.

The decision of the Examiner is reversed.

REVERSED

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